Patents

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**



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| In re Application of: | |
| **Matthew Rosenhaft** | |
| | Art Unit: **3621** |
| Serial No.: **10/037,378** | |
| | Examiner: **Cheung** |
| Filed: **October 23, 2001** | |
| For: **Telecommunication Initiated Data Fulfillment System** | |

## RESPONSE TO FIRST OFFICIAL ACTION

Commissioner for Patents
Mail Stop Non-Fee Amendment
P.O. Box 1450
Alexandria, VA 22313-1450

January 26, 2005

Sir:

In response to the Official Action mailed May 5, 2004, please enter the amendment shown in the attached Amendment Dated January 26, 2005 and consider the following Remarks.

## REMARKS

### Rejections Under 35 U.S.C. § 112

Claims 20 and 31 stand rejected under 35 U.S.C. § 112 because they claim system for performing a method. It was decided several years ago that cross-category claims are permissible. This is not reflected in the following passage in MPEP § 2106:

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I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office, Patents by facsimile directed to Examiner Cheung in Art Unit 3621 at (703) 872-9306 on January 26, 2005.

Michael J. Mehrman, Reg. No. 40,086

> To properly determine whether a claimed invention complies with the statutory invention requirements of **35 U.S.C. 101**, Office personnel should classify each claim into *one or more* statutory or nonstatutory categories. (emphasis in original)

Since that time, the undersigned submits that it has been his experience that claims in the form of claim 20 and 31 have been routinely allowed. Applicant therefore requests that this rejection be withdrawn.

**Rejections Under 35 U.S.C. § 102 and 103**

Claims 1-31 (i.e., all pending claims) stand rejected under 35 U.S.C. § 102 or 103 based on Shah, U.S. Patent No. 6,029,065 ("Shah"). These rejections are respectfully reversed for the reasons set forth below.

As a preliminary matter, please note that amendments to claim 21 has not been entered to for any reason related to patentability, but has instead been entered to broaden and clarify the claim.

Shah describes a system for activating network features, such as call forwarding, call waiting and the like to a mobile station while roaming in the service area of a local network. Shah at col. 1, lines 18-22. In the mobile station's home network, these features are activated from the mobile station by inputting pre-defined feature codes preceded and/or followed by the star (*) or pound (#) keys. Shah at col. 1, line 28. To allow the user of the mobile station to activate the same call features using the familiar home-network pre-defined feature codes while roaming, the mobile station triggers a download of feature codes from the local network's base station. Shah at col. 6, line 39 – col.7, line 17. The mobile station then uses the downloaded feature codes to translate the customary feature codes received from the user into those recognized by the base station. Shah at col. 3, lines 43-54.

The information downloaded from the base station to the mobile station contains feature codes recognized by the visited base station for activating network features that are supported by the visited network. This access information may be stored in the mobile station's memory as Reverse Channel Information Records, or in some other

memory location to which the mobile station's processor may refer to translate entries from the mobile station's menu, or other known feature code keying sequences, into the system-specific feature codes for the visited network. Shah at col. 4, lines 1-9.

This data interaction is shown diagrammatically Figs. 4-5, which show that the exchange of programming and provisioning information takes place in a bi-lateral communication and data exchange between the base station and the mobile station. Once the programming and provisioning of the mobile station has been completed, network feature activation commands are handled in the conventional manner by both the base station and the mobile station. Shah at col. 3, lines 19-24 (user-transparent feature code translation); Shah at col. 4, col. 5, lines 7-9 (translation of the mobile station's feature code home-system feature code entries into system-specific features codes for the visited network). This is the fundamental purpose of the Shah system.

Consequently, significant programming of the mobile station is required to implement the feature code download and translation system described by Shah. The system described in Applicant's specification, on the other hand, implements a fundamentally different function in a fundamentally different way. Specifically, Applicant's system requires no preprogramming of the mobile station and only requires the provisioning of a simple trigger system, for example the provisioning of the standard Advanced Intelligence Network ("AIN") trigger at the Mobile Telecommunications Switching Office ("MTSO") to recognize a trigger code including a multi-function code sequence, typically (but not necessarily) star (*) pound (#) or similar sequence. See Application at Fig. 1 and page 10, line 33 – page 11, lines 13). The AIN trigger, which is a standard feature of all AIN-enabled MTSOs, can be used to cause a data message to be routed to a data fulfillment platform. See, for example App. at Fig. 1 (element **30**) Fig. **4** (element **32**) and the accompanying text describing Fig. 1 at page 12, line 23 – page 13, line 38.

As a result, Applicant's system, unlike the Shah system, does not require preprogramming of the mobile station and may typically be implemented by activating a pre-existing trigger feature at the MTSO. Unlike the Shah system, moreover, bi-lateral communication or data exchange between the base station and the mobile station is not claimed. Applicant's system is not limited to implementing network features implemented by the telecommunications network that the mobile station is visiting, as in

the Shah system, but instead may implement such features as well as a wide range of data fulfillment functions that can be completed by a data fulfillment center or other system components activated by a data fulfillment center. In particular, Applicant's system may advantageously implement non-network functions such as, for example, vending machine activation (Fig. 1), mobile Internet access (Figs. 2 and 4), and mobile remote control of appliances (Fig. 3). These functions are not possible with the Shah system, which is limited to implementing network functions, such as call forwarding and the like. Unlike the Shah system, moreover, all of these functions are implemented outside the receiving base station and do not require a bi-lateral communication or data exchange between the base station and the mobile station.

This fundamental difference between the invention claimed in the present application and the system implemented by the Shah system is reflected in the pending claims, as illustrated below with reference to claim 1 as the prime example (equivalent and more specific claim elements are already recited in Claim 21):

> 1. (Currently Amended) A method for implementing a telecommunications initiated data fulfillment system comprising the steps of:
>
> receiving a communication comprising an input sequence including a multi-function key sequence from a telecommunications device;
>
> ***recognizing the multi-function key sequence as a trigger code;***
>
> ***identifying an identification code associated with the telecommunication device;***
>
> ***looking up a pre-defined data address associated with the input sequence, the identification code, or a combination of the input sequence and the identification code;***
>
> ***assembling a data message associated with the input sequence, the identification code, or a combination of the input sequence and the identification code;***
>
> ***transmitting the data message to the data address; and***
>
> ***implementing a response action in response to the data message.***

The combination of elements recited in claim 1 is not performed or suggested by the Shah system. In the Shah system, the receiving *base station* does not recognize a multi-function key sequence entered into the mobile station as a trigger code, but instead the *mobile station* initiates its feature code download sequence in response the autonomous registration process when it determines from a comparison of received

and stored parameters. Shah at col. 6, line 59 – col. 7, line 17. Specifically, the mobile station makes this determination by comparing the "configuration message sequence number received from the base station to the corresponding number stored in its memory." Shah at col. 7, lines 2-4. Therefore, the base station does not recognize a multi-function key sequence *entered into the mobile station* as a trigger code, as recited in claim 1. At the trigger point, in fact, the base station in the Shah system has not received anything entered into the mobile station, but is instead involved in the conventional autonomous registration process.

Similarly, the base station in the Shah system does not "look up a pre-defined data address associated with the input sequence, the identification code, or a combination of the input sequence and the identification code." In fact, the Shah system does not describe any interaction in which the base station looks up a data address because it is already in communication with the mobile station with which it needs to communicate to complete the feature code download process. Instead, the *mobile station* in the Shah system responds to detection of a data mismatch during the autonomous registration process by downloading the feature codes (referred to as "updated parameters" at col. 7, line 16) from the base station without any special action required by the base station. The mobile station subsequently sends a Page Response message to the base station a notification that it has downloaded the feature code translation information and subscribes to certain network functions, which is the same manner in which a home mobile unit would notify the base station of its subscribed network functions. Shah at col. col. 7, line 6-17. The base station therefore does nothing to trigger the feature code download, but instead operates in the conventional manner and gets notified by the mobile station of the subscribed features for the mobile station once the mobile station has triggered and completed the download of the feature codes. This is quite clearly explained in Shah at col. 6, line 59 – col. 7, line 17.

As a result, the mobile station in the Shah system must be pre-programmed in a very significant way to implement feature code download and translation based on the downloaded feature code translation information. The Shah system most definitely does not describe or suggest the base station storing or looking up a data address associated with the input sequence, the identification code, or a combination of the input sequence and the identification code in response to a trigger code recognized by

the switch in response to a multi-function key sequence entered into the mobile station. Nor does Shah describe the base station assembling and transmitting a data message in response to the trigger code. These claimed features are fundamentally different from the network feature code download and translation procedure initiated by mobile station in the Shah system, and cannot be implemented with the devices and methodology described in this reference.

Further, none of the functions recited in the dependent claims are performed by, are possible with, or are suggested by the Shah system. Referring to claim 2, for example, the base station in the Shah system is not configured to use the identification code to identify an account associated with the mobile station; and charging a cost associated with the data message to the account associated with the telecommunications device. Nor is any device described in the Shah system configured to activate a vending device, or any other external device, in response to the data message (claim 3), implement PIN-controlled functions (claim 5), initiate an Internet session between the mobile station and the Internet site (claim 7), forward the communication to a platform operated by an Internet service provider (claim 8), or transmit an email message containing promotional information regarding an item for sale associated with the activation code to an email address (claim 15). Nor is there any motivation connoted by the Shah system to customize a response action based on the location of the mobile station (claim 8) because the feature code translation information downloaded the mobile station has no relation to the mobile station's location.

It should also be appreciated that the claimed system produces many important advantages over, and overcomes significant disadvantages of, the Shah system. Importantly, for example, the use of a simple trigger system, rather than a major reprogramming of the mobile station and the mobile and base stations required to implement the Shah system, makes the claimed system much less disruptive and programming intensive to the existing infrastructure, and consequently more practical and cost effective. In addition, directing a data message associated with an incoming communication to a location such as a data fulfillment center allows the system to implement a virtually unlimited set of features, whereas the Shah system is limited to implementing pre-existing network features, such as call forwarding and the like. These

advantages – less disruptive, more practical, more cost effective, more powerful, and not limited to pre-existing network features, are major advancements that distinguish the system from the Shah system.

Paragraph 5 (b) of the Office Action asserts that col. 9 line 55 – col. 10 line 55 and col. 11 lines 6-8 of Shah disclose the step of the telecommunications switch (i.e., base station) recognizing a multi-function key sequence entered into the mobile station as a trigger code. As noted above, however, these passages do not disclose the referenced claim element. Rather, col. 9 line 55 – col. 10 line 55 of Shah discloses the *mobile station* identifying a trigger condition based on a comparison of stored and received parameters, and then downloading the host-system feature codes. See Shah at col. 6, line 59 - col. 7, line 17. The referenced passages do not teach or suggest the base station recognizing a trigger code entered into the mobile station.

Paragraph 5 (d) of the Office Action asserts that col. 9 line 55 – col. 10 line 55 and col. 11 lines 6-9 of Shah disclose the step of "looking up a pre-defined data address associated with the input sequence, the identification code, or a combination of the input sequence and the identification code." Again, these passages do not disclose the referenced claim element. Rather, col. 9 line 55 – col. 10 line 55 of Shah discloses the downloading of feature codes to the mobile station without any non-conventional intervention by the base station, and do not teach or suggest the base station looking up a data address associated with the input sequence, the identification code, or a combination of the input sequence and the identification code. Similarly, col. 11 lines 6-9 of Shah discloses the identification of the mobile station during the autonomous registration process. There is no teaching or suggestion here of the base station looking up a data address of any sort, much less one "associated with the input sequence, the identification code, or a combination of the input sequence and the identification code" as recited in claim 1.

Paragraph 5 (e) of the Office Action asserts that col. 9 line 55 – col. 10 line 55 and col. 11 lines 6-11 of Shah disclose the step of "assembling a data message associated with the input sequence, the identification code, or a combination of the input sequence and the identification code." Again, the cited passages merely describe autonomous registration and a feature code download process. The cited passages do not teach or suggest the referenced claim element, which is part of the interaction

between the host telecommunications switch and a device such as a data fulfillment center – an interaction that the Shah system does not teach or suggest. The same can be said of Paragraph 5 (f) of the Office Action.

Accordingly, Applicant respectfully submits that Shah does not anticipate or suggest and claims of the present application and cannot establish a *prima facie* case of obviousness for this invention because it does not show or suggest each element of the claimed invention. MPEP § 2143.03.

## CONCLUSION

It is believed that the preceding remarks are completely responsive to the Official Action mailed December 27, 2004, and that the claims are in condition for allowance. If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any informalities that can be corrected by an Examiner's amendment, please call Mike Mehrman at (404) 497-7400.

Respectfully submitted,

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